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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,233

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Kigen Agehara

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EXAMINER

HOWELL, DANIEL W

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

05/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,233	Applicant(s) AGEHARA ET AL.	
	Examiner Daniel W. Howell	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Before making a rejection, the Examiner will make a comment regarding one of Applicant's arguments. Particularly with regard to Bogner, Applicant has argued that member 2 corresponds to a chuck rather than being part of the drill bit itself. While the portion 1 of Bogner is certainly separable from member 2 (for instance to change the diameter of the cutting section 15), there is nothing in claims 1 or 5 which precludes the core bit from being made of two connected pieces, and one skilled in the art will certainly treat the combined parts 1 and 2 as a collective bit which may be removed from a drilling device in its entirety. One skilled in the art knows that the "entrainment parts on the drilling device" of line 50 of column 3 of Bogner is a **chuck** capable of holding the bit made collectively of members 1 and 2 of Bogner.

2. Claims 1 and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 sets forth the limitation that the locking piece is "configured to prevent movement of the core bit in an axial direction within a chuck," and claim 5 sets forth the limitation that the flange portion is "configured to prevent movement of the core bit in an axial direction within a chuck," The words "is configured to..." do not actually set forth any structure, and in order for axial movement to be prevented, some sort of cooperating structure needs to be set forth. Further, while claims 1 and 5 begin "A core bit," this limitation appears to be setting forth a combination of the bit and the chuck. Appropriate clarification is required. Claims 4 and 6 are improperly identical. Claim 6 should probably depend from claim 5.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Bogner (5174696). Note drill portion 14, blade 15, and the rearward cylindrical mounting portion 2 (note the cross section in figure 2). Portions 1 and 2 are collectively considered to be a bit, as they are placed in and removed from a chuck of a drilling machine together. Slots 11 form radial projections/locking pieces/engaging members located circumferentially between them, the locking pieces being in locked engagement with entrainment parts of the drilling device/chuck (see column 3, lines 47-52). The diameter of the engaging members formed by the slots/projections is less than the diameter of the flange adjacent the lead line for numeral 2 in figure 1. Noting that claims 1 and 5 haven't actually set forth sufficient structure for the prevention of movement in an axial direction limitation, it is well known by those skilled in the art that the outer circumference of the conical area of portion 2 of Bogner will seat in a conical seating surface of the chuck of the drilling device. Regarding claim 4, figure 2 shows three slots 11 that will form three engaging projections between them. Regarding the "flange portion is configured to prevent movement..." limitation of claim 5, it is again noted that no actual structure is presented here, and there is now confusion regarding if Applicant is claiming simply the bit or the combination of the bit and chuck. Looking at the cross section of figure 1, the flange area to the left of the lead line for numeral 2 is continuous throughout the circumference.

5. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chau-Ngoc et al (6382202). Note drill portion 1, blade 3, and the rearward cylindrical mounting portion. Slots are provided in order to form radial projections 8 in order to transmit torque from the chuck to the tool (see column 3, lines 9-15). The diameter of this engaging member 8 formed by the

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slots/projections is less than the diameter of the flange 7. Noting that claims 1 and 5 haven't actually set forth sufficient structure for the prevention of movement in an axial direction limitation, it is well known by those skilled in the art that the outer circumference of the mounting portion will seat in a seating surface of the chuck of the drilling device. Regarding the "flange portion is configured to prevent movement..." limitation of claim 5, it is again noted that no actual structure is presented here, and there is now confusion regarding if Applicant is claiming simply the bit or the combination of the bit and chuck.

6. Applicant's arguments filed 1-24-08 have been fully considered but they are not persuasive. As discussed above, there is nothing in claims 1 or 5 which precludes the bit from consisting of the two parts 1 and cylindrical mounting portion 2 of Bogner, as they are collectively inserted into and removed from the chuck of a drilling device. Applicant has argued that there is nothing in Bogner to prevent axial movement of the tool in the drill chuck, but as discussed above, no actual structure has been set forth in claims 1 and 5, and it appears the claims may now be claiming the combination of a bit and chuck. Applicant's only argument regarding Chau-Ngoc is that there is no locking piece configured to prevent movement of the bit in an axial direction. As discussed above, claims 1 and 5 don't actually set forth any explicit structure on this point, and it is not clear if the combination with the chuck is now being claimed.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, David Bryant, may be reached at 571-272-4526.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3726 at the top of your cover sheet.

/Daniel W. Howell/

Primary Examiner, Art Unit 3726